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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|------------------------|---------------------|------------------|
| 10/038,319 | 10/19/2001 | Markus Wilhelm Altmann | CM2462 | 7232 |

27752 7590 04/11/2005

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|------------------|--------------|
| EXAMINER | |
| BOYER, CHARLES I | |
| ART UNIT | PAPER NUMBER |
| 1751 | |

DATE MAILED: 04/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/038,319

Applicant(s)

ALTMANN ET AL

Examiner

Charles I. Boyer

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is responsive to applicants' amendment and response received January 18, 2005. Claims 1-20 are currently pending.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Canivenc et al, US 5,540,952.

Canivenc et al teach a textile softening process using a composition comprising a polyorganosiloxane with a sterically hindered functional group (see abstract). The softener of Canivenc et al appears to be identical, and used for the identical purpose, that is, fabric softening, as the softener of the present claims. Applicants acknowledge this on page 2, lines 12-16 of the present specification which reads "The use of aminosilicones comprising sterically hindered functional groups to treat textiles in an industrial context has been disclosed in US 5,540,952." Applicants appear to be basing their claim of patentability on the fact that their claims are drawn to a "domestic" process, and not an industrial process as taught by the prior art. However, this is merely a preamble limitation. A preamble is generally not accorded any patentable weight where it merely recites the **purpose of a process** or the intended use of a

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structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). The only actual process step is a step of "providing" a composition to clothes. This process step is met by the reference and therefore satisfies this limitation. With respect to the composition containing a perfume, the examiner notes that every fabric softener known contains a pleasing fragrance, i.e. perfume.

Applicants have traversed this rejection on the grounds that the industrial process taught by the reference cannot render obvious a process for the domestic treatment of clothes. Applicants' arguments have been carefully considered but are not found to be persuasive in view of the remarks above with respect to preamble limitations.

3. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Branlard et al, WO 97/33034.

Branlard et al teach a textile softening process using a composition comprising a polyorganosiloxane with a sterically hindered functional group (see abstract). The softener of Branlard et al appears to be identical, and used for the identical purpose, that is, fabric softening, as the softener of the present claims. Applicants appear to be basing their claim of patentability on the fact that their claims are drawn to a "domestic" process, and not an industrial process as taught by the prior art. However, this is

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merely a preamble limitation. A preamble is generally not accorded any patentable weight where it merely recites the **purpose of a process** or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). The only actual process step is a step of “providing” a composition to clothes. This process step is met by the reference and therefore satisfies this limitation. With respect to the composition containing a perfume, the examiner notes that every fabric softener known contains a pleasing fragrance, i.e. perfume.

Applicants have traversed this rejection on the grounds that the industrial process taught by the reference cannot render obvious a process for the domestic treatment of clothes. Applicants' arguments have been carefully considered but are not found to be persuasive in view of the remarks above with respect to preamble limitations.

4. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirk, US 5,147,578.

Kirk teaches amino/polyalkoxylated polydiorganosiloxanes for use in textile softening compositions (see abstract). The softener of Kirk may contain cyclohexane or phenyl functional groups, thereby satisfying the “sterically hindered functional groups” limitation of the present claims (col. 2, lines 1-50).

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Accordingly, it would have been obvious to one of ordinary skill in the art to formulate a softening composition containing a sterically hindered functional group based on the teachings of Kirk and so meet the limitations of the claims at hand.

Applicants have traversed this rejection on the grounds that the functional groups of Kirk do not provide steric hindrance, however, they have not provided any evidence that this is so. The present claims do not define the degree of steric hindrance required in the aminosilicone, therefore even a very small amount of hindrance will satisfy the claim limitations. The examiner maintains a phenyl functional group will provide at least some steric hindrance and so meet the present claim limitations.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of


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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles I Boyer whose telephone number is 571 272 1311. The examiner can normally be reached on M-F 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on 571 272 1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Charles I Boyer
Primary Examiner
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